

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue application of:

Examining Group: 2621

Geoffrey B. Rhoads

Confirmation No.: 3644

Application No.: 10/766,750

Filed: January 27, 2004

For: METHODS FOR SURVEYING
DISSEMINATION OF PROPRIETARY
EMPIRICAL DATA

VIA ELECTRONIC FILING

Examiner: J. Couso

Date: May 15, 2007

INTERVIEW SUMMARY

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Following up the telephone interview held on November 1, 2005, Applicant provides the following interview summary:

Interview Summary

Applicant thanks Examiner Couso for conducting a telephone interview on November 1, 2005. The interview was hosted by Examiner Couso and included Examiner Couso's SPE, the SPRE then responsible for this case, and Attorneys for Applicant, Joel Meyer and Steve Stewart.

In the Interview, the SPRE stated the general position that changes cannot be made to the specification of a patent as determined at the time of its issue date that would broaden the claims beyond the two year deadline for a broadening reissue. The SPRE generally raised a hypothetical in which addition of a new embodiment to the specification would cause the claims to cover a process that was not covered in the original patent.

Attorney for Applicant pointed out that the Office's rejection had not identified how the proposed re-insertion of the Appendix B source code would specifically broaden any claim in U.S. Patent 5,862,260 (the '260 patent). As such, there was and still is no basis for maintaining any broadening reissue rejection. Based on communications with the Examiner after the Interview, it is now understood that the Office allowed the reissue application in response to the interview on November 1, 2005. Presumably, at the time of the allowance at or around November 1, 2005, the Office agreed with Applicant's position that the amendment re-inserting the source code originally filed with the application that issued as the '260 patent did not impermissibly broaden the claims of the '260 patent. Not knowing that the application had been allowed, Applicant filed a supplemental response on November 16, 2005. In response to this supplemental response, the Office again allowed the application, but apparently later discovered problems with the format of the supplemental response which cast the reissue application status in doubt. Applicant now petitions to revive the application and files an RCE so that the Office will consider this Interview Summary and accompanying response.

While the following remarks appear to be moot in view of the Office's allowance of the reissue application after the Interview, Applicant submits them so that the Office can re-consider the issue of the final Rejection in light of the clarification that occurred in the November 1, 2005 interview.

Sections 1 and 4 of the final Office Action are inconsistent with the Office's position stated in the November 1, 2005 interview because they are based on alleged differences between the proposed amendments and the original application. In particular, the Office Action indicated in section 4 that "the examiner would have no problem entering the same exact Appendix as found in the original application." Based on this representation, Applicant had previously demonstrated through a declaration and references to the original application that Appendix B and the amendments consisted of the same material as the original application.

In the November 1, 2005 interview, the SPRE clarified that the Office's concern was not new matter relative to the original application, but rather, it was concerned with a potential broadening of the claims, which is to be evaluated relative to the patent as issued, not relative to the original application.

In view of the foregoing, the Office representatives indicated that they would vacate the final rejection and issue a new action identifying how the patent claims had been broadened, if at all. Applicant's understanding is that the Office vacated the rejection and allowed the reissue application, apparently not finding any broadening of the claims.

Applicant makes the following comments regarding the rejection in section 2 of the final Office Action. The section 2 of the final rejection indicated that the prior amendments to cols. 1 and 90 made the claims broader in scope. The mere references to the source code listing do not broaden any of the claims. The amendment to col. 90 refers to the source code listing as representing a steganographic marking/decoding "plug-in" for use with Adobe Photoshop software. The specification of the '260 patent refers to the incorporation of steganographic software in Adobe products a number of times. See, for example, col. 23, lines 7-15, and col. 90, lines 62-66. Thus, the mere fact that the proposed amendment refers to a plug-in within Adobe Photoshop software does cause a broadening of the claims. Apparently, the Office agreed with this reasoning when it allowed the reissue application after the November 1, 2005 interview.

The possibility that Appendix B includes other material that does not constitute an embodiment of any claim in the '260 patent is not relevant to the new matter issue because such other material, to the extent it exists, cannot broaden the claim if it does not relate to or support the claim language.

Date: May 15, 2007

Respectfully submitted,

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